

Remarks

The Examiner objected to Figure 1 because it fails to provide text labels. As the Examiner will note by reference to the drawing amendments made herein, a new Figure 1 has been provided with text labels. With the entry of this drawing, this objection now falls away.

The Examiner objected to the specification due to certain informalities. First, the Examiner asserted that section headings should be provided and that paragraph numbers should be removed. As the Examiner will note by reference to the specification amendments made above, section headings have been added at two points in the specification. However, with respect to the paragraph numbers on page 10 of the application, it is not understood why they need to be removed. The Examiner should note the second to last paragraph on page 10 of the application as filed, wherein the specification indicates that with respect to Figure 2, it illustrates the detailed operation of the system that comprises the following steps. At that point, the steps are labeled as S1-S18. Also, within the steps, there are references to other steps. See, for example, step S14 on page 13 of the application. It should be obvious that deleting these step numbers would not act to clarify the specification, but would rather confuse it considerably. Moreover, it is respectfully noted that the Examiner has not cited any Rule of Statutory provision that supports any need to remove paragraph numbers. As such, the Examiner is respectfully requested to withdraw the requirement.

With respect to the guidelines set forth in part six of the official action, the Examiner is thanked for providing this information to Applicant. However, as indicated by 37 CFR 1.77(b), the provision is not mandatory as evidenced by the use of the word "should" in several places.

Turning now to the issue raised by the Examiner in paragraph 7 of the official action, the Examiner objected to claims 9 and 18 as allegedly being informal. As the Examiner will note by reference to the claim amendments made above, it is believed that this grounds for objection has been addressed. It is asserted that the scopes of claims 9 and

18 are in no way affected by this amendment. Moreover, there is nothing improper about using "and/or" in patent claims. A quick search at www.uspto.gov will show that over 100,000 issued US Patents use that terminology in the claims.

Moving on, the Examiner rejected the claims under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. The Examiner asserts that because "the domain provided in the e-mail address is often sufficient to specify the server to which the user belongs..." it would appear that the user is, in fact, able to specify their server.

With all due respect to the Examiner, it is submitted that the Examiner's assertion is incorrect. The undersigned currently has an e-mail account with earthlink.net. In the e-mail program that the undersigned uses, the undersigned must specify both an incoming mail server and an outgoing mail server. Neither one is simply called earthlink.net. The incoming server is called pop.earthlink.net and the outgoing server is called smtpauth.earthlink.net. Sometimes, of course, the incoming mail server and the outgoing mail server will have the same name such as, possibly, mail.earthlink.net. However, it is believed that, seldom, if ever, is the incoming mail server and/or the outgoing mail server simply at a second level domain name such as earthlink.net. And, if it is, that hardly detracts from the present invention.

With respect to the Examiner's citation of the '298 patent, the Examiner should read the paragraph bridging columns 7 and 8 where the description of making the connection and connecting to the post office is discussed. As is described, the communications device locates the post office numerical IP address which corresponds to the mailbox identified at 402 using the DNS system. However, it should be noted that there is absolutely no suggestion in the '298 patent that the domain name for the post office (which is often a third level domain name) corresponds to the domain name used with an e-mail address (which is often a second level domain name).

The Examiner goes on to state that for the purposes of applying prior art, that the Examiner will give very little patentable weight to this limitation of the claims. If that is the case, then the Applicant is prepared to take this matter to the Board of Appeals where patentable weight is given to each and every limitation of the claims. It is

submitted that the Examiner is not entitled to ignore limitations of the claims.

Turning now to the prior art rejections, the Examiner rejects claims 1 and 10 as allegedly being fully anticipated by US Patent no. 5,805,298 to Ho. This grounds for rejection is respectfully traversed.

The Examiner is invited to read column 6, lines 24-56 of Ho. What is stated there is basically an oversimplification of how the Internet really works. For example, Ho suggests that an e-mail address typically takes the form of mailboxname@domainname. Ho is correct in that regard. However, typically, the machine associated with a user's post office address is at a different third level domain name as previously described. Indeed, the incoming mailbox may be at a different third level domain name while the outgoing mailbox may be a still different third level domain name. Indeed, the Examiner is invited to look at the e-mail program running on his own computer. The Examiner's e-mail address is something like mailboxname@uspto.gov. However, in all likelihood, the machines that handle the Examiner's e-mail traffic are at some other domain name, such as mail.uspto.gov.

And while the machines that handle the mail may be identified as mail.uspto.gov, in the case of the patent office, there is no requirement that they be so named. They could just as well be named pop.uspto.gov, or smtp.uspto.gov or even oscar.uspto.gov.

Thus, just because a person knows the domain name that their mail box is associated with, they do not necessarily know the domain name that their post office is associated with. And while it is true that those post offices often have certain predictable names, you can imagine how long the undersigned might have spent trying to guess his outgoing mail server is at smtpauth.earthlink.net.

So, it may be that some users are lucky enough to have their post office have the exact same domain name as their mailbox. But, for most users, it is believed that is not the case and if the Examiner checks his own mailbox there at the USPTO, it is believed that the Examiner will find that is not the case for his mailbox either. And, if your post office

is at something like smtpauth.earthlink.net, you can just imagine how much time a person could spend guessing at what the third level domain name is of that machine. Obviously, for most of us, we end up getting information from technical support in order to get the addresses of both the incoming and outgoing mail servers because they are not simply addressed as the Examiner seems to assert in the official action.

And, even if some mail servers are so simply addressed, for most of us that is not the case. The present invention as recited by claim 1 provides a solution for this problem.

Claim 1 includes a number of limitations. One of the limitations recites "parsing the mail address to identify and remove the user identifier from the mail address and thereby obtain a presumed domain name of the user's server." The Examiner asserts that this is taught by Ho, citing column 6, lines 57-61. While there is discussion of parsing a "destination identifier", but the parsing is done merely to see if the destination identifier has a "@" character therein. This is done merely to distinguish between fax transmissions and e-mail transmissions. See column 6, lines 24-27. There is no discussion of obtaining "a presumed domain name of the server's user" by such parsing. Claim 1 is clearly not anticipated by Ho.

Turning now to page 7 of the official action, the Examiner rejects claims 1-18 under 35 U.S.C. 103 as being unpatentable over Ho in view of Smith and Stevens. This grounds for rejection is respectfully traversed.

With respect to claim 1, neither Smith nor Stevens helps the Examiner with respect to the deficiencies in Ho noted above.

Turning to claim 3, claim 3 recites, amongst other things, "listing the responses received from the DNS database; checking the responses in turn to determine whether a predetermined port or ports associated with the predetermined protocol or protocols are open or closed; and identifying a response having an open port or ports as the user's server." The Examiner directs the Applicant's attention to pages 201-202 and 448-451 of Stevens for the use of MX queries. While claim 3 does recite sending out a MX

query, what about the remaining portions of claim 3 which are quoted above? Please either withdraw the rejection or specify in the manner required by 37 CFR 1.104, exactly where the prior art allegedly teaches those limitations.

Turning to claim 4, claim 4 recites, amongst other things, "storing all of the IP addresses having open port status in the access database; interrogating the stored IP addresses with the user's address and password and identifying a successful address as the user's server." Where is that shown in the prior art cited by the Examiner? With respect to claim 4, the Examiner merely tells the Applicant to look at Stevens for the discussion of the use of MX records. That is fine, so far as it goes, but where does Stevens suggest "storing all of the IP addresses having open port status in an access database" or "interrogating the stored IP addresses with the user's address and password" or "identifying a successful address as the user's server"? It is not seen how a mere discussion of MX queries meets those limitations. Please either withdraw the rejection or specify in the manner required by 37 CFR 1.104, exactly where the prior art allegedly teaches those limitations.

Claim 5 recites "requesting the full list of host names for the presumed domain name by DNS zone transfer, checking the open or closed status of the predetermined ports of the listed host names in turn and identifying a host having an open port status as the user's server." The Examiner points, with respect to claim 5, to page 190 of Stevens for a discussion of zone transfers. While the discussion of zone transfers is very nice, claim 5 has a lot more in it than a mere zone transfer. Note the fact that claim 5 recites "checking the open or closed status of the predetermined ports of the listed host names in turn and identifying a host having an open port status as the user's server." Does the Examiner suggest that is disclosed as page 190 of Stevens? If so, exactly where on that page is it disclosed?

Finally, what is the motivation for combining Stevens and Ho? Why would Ho do zone transfers particularly when, according to the Examiner, Ho starts off with the assumption that they already know what the post office address is (because it is probably stored someplace)? So, exactly what is the motivation for combining Stevens

and Ho with respect to the subject matter of claim 5?

Turning to claim 6, the Examiner tells the Applicant that this claim, and other claims recite specific steps which are “well known” within DNS routing methods and that these methods are “inherent” to Ho and “specifically disclosed” in Stevens. The Examiner goes on to allege that because of their “inherency” it is not necessary to provide a motivation for combining the references.

With all due respect to the Examiner, the reason why the Examiner has not provided a motivation for combining the references is that it does not exist in the prior art. The only place that the Examiner can find the motivation for combining the references is from Applicant’s own disclosure. It is improper to use Applicant’s own disclosure against Applicant.

As noted above, Ho operates from the viewpoint, as admitted by the Examiner, that the post office address is known. If the post office address is known, then you do not have to go through any sort of scheme to try to determine what the user’s server (i.e. the post office address) might be. The positions being taken by the Examiner are utterly inconsistent with each other.

Moreover, the Rules of Practice require that the Examiner point out, with specificity, exactly where each and every limitation of each and every rejected claim can be found in the prior art. Telling the Applicant that there is a book “Stevens” that the Applicant should read to sort these matters out is not a proper way of citing a prior art reference. The Rules of Practice put the onus on the Examiner to cite the particular part of a prior art reference as nearly as practicable. See 37 CFR 1.104(c)(2).

Turning briefly to claim 8, the Examiner asserts that it would have been obvious to modify the teachings of Ho and Stevens by “dividing the database into first and second tables wherein the first table includes records of user’s mail addresses and the address of the corresponding servers...” With all due respect to the Examiner, earlier on in the official action when the Examiner was considering what was meant by the term “access

database” the Examiner points the Applicant to a local DNS database. Please see the second whole paragraph on page 8 of the official action. Since the Examiner is reading the term “access database” on a local DNS server, how would a local DNS server possibly store “records of user’s mail addresses” as suggested by the Examiner in the official action? What is the motivation for storing an e-mail address in the DNS server? It is suggested, with all due respect to the Examiner, that the only place that the Examiner found motivation to do this was from Applicant’s own disclosure!

The Examiner is unfairly using Applicant’s own disclosure against Applicant in making these rejections. It is apparent that the Examiner is using the claims as a road map to the prior art as opposed to considering what the prior art really teaches. By using the claims as a road map to the prior art, the Examiner basically assumes the motivation for making a combination, and then does an after the fact analysis of the prior art to locate references supporting his position. However, the real question is whether or not the references, by themselves, suggest the combination that the Examiner is now suggesting. It is submitted, with all due respect to the Examiner, that the prior art references do not suggest the combinations that the Examiner asserts in the official action.

Reconsideration of this application as amended is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents

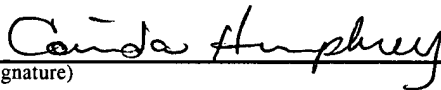
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(Name of Person Signing)

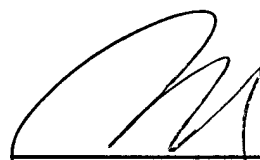


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Respectfully submitted,



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